THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES O. SMITH

Appeal No. 1997-3276
Application No. 08/478,567

ON BRIEF

Before HAIRSTON, DIXON, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 40-50. We reverse.

BACKGROUND

Each year, countless telephone books are printed and distributed to households and businesses around the world. Two problems plague these paper books. The first problem

relates to updating data. Although only some data in a given book changes, the entire directory is updated annually. Consequently, an enormous amount of energy and natural resources are consumed to revise a small amount of data.

The second problem relates to advertising goods or services. To save money, a business will often advertise in only one section of a given book. Consequently, a potential customer searching for a particular good or service may not get a full listing of providers from the book.

The invention at issue in this appeal is an electronic telephone book. A modem couples the electronic book to a telephone line. A user may retrieve current data from a telephone company's central office through the telephone line. Such retrieval eliminates the need to reprint a paper telephone book annually.

A display of the electronic book comprises output and input circuitry. The output circuitry displays user data and control graphics. The input circuitry generates control

signals responsive to a user's interaction with the control graphics. The user can employ the output and input circuitry to search on several fields including name, category, or keywords. Such searching providing a fuller listing of advertisers.

Claim 40, which is representative for our purposes, follows:

> 40. An electronic phone book comprising:
> processing circuitry;
> telephone interface circuitry for coupling the processing circuitry to a telephone line;
> a display comprising output circuitry to output information and a control menu to input criteria data insufficient to obtain a unique telephone number based on said criteria data and sufficient to obtain a plurality of criteria telephone numbers based on said criteria data and input circuitry for generating control signals responsive to user interaction with said control menu; and
> communication circuitry coupled between said processing circuitry and said telephone line for retrieving said criteria telephone numbers for said display via the telephone line, said communication circuit being responsive to said control signals.

The references relied on in rejecting the claims follow:

Johnston et al. (Johnston) 4,814,760 Mar. 21, 1989

Ishizu et al. (Ishizu)	4,822,751	Apr. 18, 1989
Noto et al. (Noto)	4,885,580	Dec. 5, 1989
Iggulden	4,933,968	Jun. 12, 1990

Sato et al. (Sato) (European Patent Application)	0 354 703	Feb. 14, 1990
Walsh (UK Patent Application)	2 165 420	Apr. 9, 1986
Matsui (Japanese Patent Application)	62-157447	Jul. 13, 1987.

Claims 40, 41, and 46-49 stand rejected under 35 U.S.C. § 103 as obvious over Noto in view of Iggulden. Claim 42 stands rejected under 35 U.S.C. § 103 as obvious over Noto in view of Iggulden further in view of Ishizu. Claims 43-35 stand rejected under 35 U.S.C. § 103 as obvious over Noto in view of Iggulden further in view of Johnston. Claim 50 stands rejected under 35 U.S.C. § 103 as obvious over Noto in view of Iggulden further in view of Matsui.

Claims 40, 41, and 46-49 also stand rejected under 35 U.S.C. § 103 as obvious over Noto in view of Walsh. Claim 42 also stands rejected under 35 U.S.C. § 103 as obvious over Noto in view of Walsh further in view of Ishizu. Claims 43-35 also stand rejected under 35 U.S.C. § 103 as obvious over Noto in view of Walsh further in view of Johnston. Claim 50 also

stands rejected under 35 U.S.C. § 103 as obvious over Noto in view of Walsh further in view of Matsui.

Claims 40, 41, and 46-49 further stand rejected under 35 U.S.C. § 103 as obvious over Sato in view of Iggulden. Claim 42 further stands rejected under 35 U.S.C. § 103 as obvious over Sato in view of Iggulden further in view of Ishizu. Claims 43-35 further stand rejected under 35 U.S.C. § 103 as obvious over Sato in view of Iggulden further in view of Johnston. Claim 50 further stands rejected under 35 U.S.C. § 103 as obvious over Sato in view of Iggulden further in view of Matsui.

Claims 40, 41, and 46-49 also stand rejected under 35 U.S.C. § 103 as obvious over either Sato in view of Walsh. Claim 42 also stands rejected under 35 U.S.C. § 103 as obvious over Sato in view of Walsh further in view of Ishizu. Claims 43-35 also stand rejected under 35 U.S.C. § 103 as obvious over Sato in view of Walsh further in view of Johnston. Claim 50 also stands rejected under 35 U.S.C. § 103 as obvious over Sato in view of Walsh further in view of Matsui. Rather than

repeat the arguments of the appellant or examiner in toto, we refer the reader to the brief and answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejections advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellant and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 40-50. Accordingly, we reverse.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

> In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With these in mind, we consider the appellant's argument and the examiner's reply.

Regarding the obviousness of claims 40-50, the appellant's argument follows.

> [S]ince none of the applied references discloses or suggests the presently claimed invention including the control menu to input criteria data insufficient to obtain a unique telephone number based on the criteria number and sufficient to obtain a plurality of criteria telephone numbers based on the criteria data and communication data for retrieving the criteria telephone numbers for the display via the telephone line, the combination of these applied references do not disclose or suggest the presently claimed invention. (Appeal Br. at 7.)

The examiner replies, "**The electronic phone book is disclosed by both Noto or Sato.**" (Examiner's Answer at 16.) He adds, "Iggulden does disclose retrieving and storing a telephone number from a telephone line and it is extremely important since the resulting combination would disclose or suggest the claimed invention to one of ordinary skill in the art." (Id.) The examiner also adds the following assertion.

> Walsh is relied upon to show that it is well known to dial into an electronic directory service and retrieve a wanted telephone number and to also store and display the thus retrieved telephone number at the subscriber station for future use such that the correct updated telephone number for addressing a call is obtained for use[d] by the user. (Id. at 19.)

"Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 519 U.S. 822 (1996) (citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "'[T]he question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie,
974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)(citing In re Gorman, 933 F.2d 982, 987,
18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

Here, the examiner fails to identify a sufficient suggestion to combine either Iggulden or Walsh with either Noto or Sato. Both Noto and Sato teach storing telephone numbers in and retrieving telephone numbers from a local database. Specifically in Noto, the telephone numbers are stored in a memory section 8 of a multi-function key input device. Col. 3, ll. 32-33. Specifically in Sato, the telephone numbers are stored in storage areas 88f and 88g of an information processing apparatus. Col. 17, ll. 18-19. The disclosures of the references reveal that both Noto's device and Sato's apparatus are complete, self-contained units designed to operate with a local database.

Rather than providing a line of reasoning to explain why combining Iggulden's or Walsh's teaching of using a remote database with Noto's self-contained device would have been desirable, the examiner merely concludes, "it would have been obvious ... to modify Noto to use the communication means (in the electronic telephone book) to retrieve a telephone number via the telephone line for storage and display in response to user input command for subsequent use." (Examiner's Answer at

6, 8-9.) He makes a similar conclusion regarding combining Iggulden's or Walsh's teaching with Sato's self-contained apparatus. (Id. at 11, 13.) Because all relevant telephone numbers are stored in both Noto's device and Sato's apparatus, however, there is no need to find additional numbers stored remotely. The examiner's combination of references would require a change in the basic principles under which Noto's device and Sato's apparatus were designed to operate. The examiner fails to allege, let alone show, that Ishizu, Johnston, or Matsui remedies these defects.

Because neither Noto's device nor Sato's apparatus needs to use telephone numbers stored remotely, we are not persuaded that the prior art would have suggested the desirability, and thus the obviousness, of combining either Iggulden's or Walsh's teaching of using a remote database with either Noto's or Sato's teaching of a local database. The examiner's conclusions impermissibly rely on the appellant's teachings or suggestions to piece together the teachings of the prior art. He has not established a prima facie case of obviousness.

Therefore, we reverse the rejections of claims 40-50 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the rejections of claims 40-50 under 35 U.S.C. § 103 are reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
JOSEPH L. DIXON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)	

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